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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,697	04/09/2004	Robert P. Bishop	31141-101	1539
26486 7590 04/04/2008 BURNS & LEVINSON, LLP 125 SUMMER STREET BOSTON, MA 02110				
EXAMINER				
DREIDAME, HUNTER M				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
04/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,697

Applicant(s)

BISHOP, ROBERT P.

Examiner

HUNTER M. DREIDAME

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8-13 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5, 9 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 8, 10-13 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 March 2008 has been entered.

Drawings

The drawings were received on 14 March 2008. These drawings are accepted.

Claim Objections

Claims 8, 24 and 27 are objected to because of the following informalities:

The preamble of claims 8 and 24 draws to a dependence upon claim 1; the preamble of claim 27 draws to a dependence upon claim 20. Claim 1 has been cancelled and claim 20 has been withdrawn. For purposes of examination, the examiner is reading the claims 4 and 24 as dependent upon independent, new claim 21 and claim 27 as dependent upon new claim 22.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 8, 10, 11, 13, 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,435,887 to Anderson.

As to claim 21, Anderson discloses a clip (Fig. 3) capable of securing objects to a top surface of a deck having spaced apart, and parallel to each other, elongated deck members with top and bottom surfaces and being of substantially uniform thickness, with sides of adjacent ones of the members substantially parallel to each other and spaced by a small gap in relation to member thickness, comprising: an elongated wire (line 75, col. 2) of high strength, corrosion resistant material, the wire being shaped to provide an aperture forming closed head (space between 7, 8) and leg portions (10) extending therefrom, closely spaced to and essentially parallel to each other (shown in Fig. 2), and terminating at distal ends in feet (11) orthogonal to the legs forming, outward extending portions, all in a common plane the legs being of a length such that the wire clip can be inserted down between spaced adjacent deck members with its said plane substantially parallel to the sides of those members past the full thickness thereof and then partially rotated and pulled upwards so the feet bear up against bottoms of those deck members and the aperture head also clears the member, and the aperture head and total span of the feet both being larger than the gap between said adjacent deck members and impassable through the gap unless the clip is oriented with its said plane substantially parallel to the sides of the deck members on both sides of the gap (shown in Figs. 1 and 3).

As to claim 4, Anderson discloses the clip of claim 21, wherein the clip is of wire or wire-like (line 75, col. 2) and the feet are substantially co-planar with the head (shown in Fig. 2).

As to claim 8, Anderson discloses the clip of claim 21, wherein the legs are spring-loaded to separate from one another so as to each engage an opposing surface member (shown from Fig. 3 to Fig. 2).

As to claim 10, Anderson discloses the clip of claim 21, wherein the head is formed in a shape selected from the group consisting of rings, ellipsoids, and multi-sided shapes (multi-sided shape shown in Fig. 2).

As to claim 11, Anderson discloses the clip of claim 21, wherein the said material is composed of a high-strength, corrosion-resistant material (lines 74-76, col. 2).

As to claim 13, Anderson discloses the clip of claim 21, wherein the clip is composed of a spring-tempered material (lines 74-76, col. 2).

As to claim 25, Anderson discloses a clip (Fig. 3) capable of securing objects to a top surface of a dock having spaced apart and parallel to each other, elongated deck members of substantially uniform thickness with sides of adjacent ones of the members substantially parallel to each other and spaced by a small gap in relation to member thickness comprising an elongated wire of high strength, corrosion resistant material (lines 74-76, col. 2), the wire being shaped to provide forms an aperture forming closed head (area within 7, 8) and elongated leg portions (10) extending therefrom closely spaced and essentially parallel to each other and terminating at distal ends in feet (11)

orthogonal to the legs and thus forming outward extending portions, all in a common plane, the legs being of a length such that the wire clip can be inserted down between spaced adjacent dock members with its said plane substantially parallel to the sides of those members past the full thickness thereof and partially rotated and pulled upwards so the feet bear up against bottoms of those members and the aperture head clears the tops of those members, and the aperture head and total span of the feet both being larger than the gap between said adjacent dock members and impassable through the gap unless the clip is oriented with its said plane substantially parallel to the sides of the dock members (shown in Figs. 2, 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,435,887 to Anderson.

As to claim 12, Anderson discloses the claimed invention except for clip being made of stainless steel, brass, aluminum, or plastic. It would have been a matter of obvious design choice to form the clip out of stainless steel, brass, aluminum, or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious

design choice. In re Leshin, 125 USPQ 233. Stainless steel, brass, aluminum, and plastic are all well known materials for use in making clips and would have been obvious material choices at the time of the invention for their inherent material properties such as resilience and ease of shaping, along with the convenience of such materials being readily available and inexpensive.

As to claim 24, Anderson discloses the claimed invention except for specific size of the legs. It would have been a matter of obvious design choice to the legs larger or smaller, as such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being with the level of ordinary skill in the art. In re Rose, 105 USPQ237 (CCPA 1955).

Claims 22, 23, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 3,703,875 to Gunvalson in view of U.S. Patent 1,435,887 to Anderson.

As to claim 22, Gunvalson discloses a clip (10) in combination with a deck (21, 22) having spaced similar members with sides parallel to each other and adjacent members separated by small gap in relation to member thickness (shown in Fig. 3), the clip having an aperture head portion (16) on top of the adjacent members and orthogonal thereto and feet (12, 13) below the members and orthogonal to the members to grip the members' undersides when a pulling up load is applied to the heads.

Gunvalson does not disclose the combination employing a plurality of clips as claimed in claim 21.

Anderson discloses the clips as claimed in claim 21.

In view of Anderson, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the clip of Anderson in the combination taught by Gunvalson, as the feet (11) of Anderson would grip the underside of the deck in the same manner as the feet (12, 13) of Gunvalson, and the lower edges (9) of the aperture of Anderson would grip the upper side of the deck in the same manner as the arms (14, 15) of Gunvalson, seeing as Gunvalson simply teaches mooring a device to a deck via a clip which can grip the deck.

As to claim 23, Gunvalson, in view of Anderson, discloses the combination of claim 22 wherein the members are at least one inch thick and the clips' legs are at least as long as the thickness of the members (Gunvalson, lines 36-41, col. 3).

As to claim 26, Gunvalson discloses a clip (10) in combination with a dock (21, 22) having spaced similar members with sides parallel to each other and adjacent members separated by small gap in relative to member thickness (shown in Fig. 3), the clip having a head (16) on top of the adjacent members and orthogonal thereto and feet (12, 13) below the members and orthogonal to the members to grip the members' undersides when pulling up load is applied to the heads.

Gunvalson does not disclose the combination employing a plurality of clips as claimed in claim 25.

Anderson discloses the clips as claimed in claim 25.

In view of Anderson, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the clip of Anderson in the combination taught by Gunvalson, as the feet (11) of Anderson would grip the underside

of the deck in the same manner as the feet (12, 13) of Gunvalson, and the lower edges (9) of the aperture of Anderson would grip the upper side of the deck in the same manner as the arms (14, 15) of Gunvalson, seeing as Gunvalson simply teaches mooring a device to a deck via a clip which can grip the deck.

As to claim 27, Gunvalson, in view of Anderson, discloses the combination of claim 22 wherein the members are at least two inches thick and the clip legs are at least as long as the thickness of the members (lines 36-45, col. 3).

As to claim 28, Gunvalson discloses a method of securing objects (17) to a top surface of a deck or a dock having spaced apart parallel elongated members (21, 22) of substantially uniform thickness with sides of adjacent ones of the members substantially parallel to each other (shown in Fig. 3), adjacent members being spaced by a small gap in relation to member thickness, comprising providing clips (10) made of high strength, corrosion resistant material (lines 24-26, col. 3), the wire being formed with an aperture forming closed head (16) and a leg portion (11, 11a) extending therefrom a distal end in feet (12, 13) orthogonal to the leg and thus forming outward extending portions, all in a common plane, such that the clip can be inserted down between spaced adjacent members with its plane parallel to the sides of those members past the full thickness thereof, the aperture arms (14, 15) and total span of the feet being larger than the space between said adjacent member and impassable through the space between adjacent deck members unless the clip is oriented substantially parallel to the sides of the head members and the legs being at least as long as the thickness of such members (shown in Fig. 3), inserting the clips between adjacent deck members so that legs are bounded

by the spaced members and the head and feet are clear of them, partially rotating the clip so the head and feet are substantially orthogonally oriented to the direction of elongation of the members (lines 44-45, col. 2), and tying one or more ropes or cords (17) to aperture heads of spaced such inserted and rotated clips and using such ropes or cords to cover or tie down one or more objects to be secured to the deck or dock.

Gunvalson does not disclose clips made of elongated wire, the wire being formed with an aperture forming closed head and leg portions extending therefrom closely spaced to and essentially parallel to each other and terminating at distal ends in feet orthogonal to the legs and thus forming outward extending portions, all in a common plane, such that the wire can be inserted down between spaced adjacent members with its plane parallel to the sides of those members past the full thickness thereof, the aperture head and total span of the feet being larger than the space between said adjacent member.

Anderson discloses clips (Fig. 3) made of elongated wire (lines 74-76, col. 2), the wire being formed with an aperture (area between 7, 8) forming closed head and leg portions (10) extending therefrom closely spaced to and essentially parallel to each other and terminating at distal ends in feet (11) orthogonal to the legs and thus forming outward extending portions, all in a common plane (shown in Fig. 2), such that the wire can be inserted down between spaced adjacent members with its plane parallel to the sides of those members past the full thickness thereof, the aperture head and total span of the feet being larger than the space between said adjacent member.

In view of Anderson, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the clip of Anderson in the method taught by Gunvalson, as the feet (11) of Anderson would grip the underside of the deck in the same manner as the feet (12, 13) of Gunvalson, and the lower edges (9) of the aperture of Anderson would grip the upper side of the deck in the same manner as the arms (14, 15) of Gunvalson, seeing as Gunvalson simply teaches mooring a device to a deck via a clip which can grip the deck.

Response to Arguments

Applicant's arguments with respect to claims 4, 8, 10-13, and 21-28 have been considered but are moot in view of the new ground(s) of rejection.

The declaration under 37 CFR 1.132 filed 14 March 2008 is insufficient to overcome the rejection of claims 4, 8, 10, 11, 13, 21 and 25 based upon Anderson as set forth in this Office Action because: Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

The declaration under 37 CFR 1.132 filed 14 March 2008 is insufficient to overcome the rejection of claims 14, 22-24 and 26-28 based upon 35 USC § 103 as set forth in this Office action because:

The applicant fails to establish a nexus between the novel features of the invention and the commercial success; the showing of commercial success must be

commensurate with the scope of the claims. The best showing is that the invention has displaced competitors' product in the marketplace.

Applicant has submitted testimonials from satisfied customers as evidence of commercial success. Examiner asserts that no nexus has been established. In order for a nexus to be established, the Applicant must present data to prove that his or her invention has displaced that of the other similar inventions on the market, and applicant must further show how that displacement directly correlates to the patentable feature of the invention. Applicant has presented no data on the sales of the competition and the respective sales of the applicant, and therefore no nexus has been established.

Remarks

It should be noted that, in accordance with 37 CFR 1.121(C) (4), applicant should not be presenting the text of cancelled claims. As such, Applicant is requested to delete the text of currently cancelled claims 1, 2, 6, 7, 14, and 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNTER M. DREIDAME whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hunter M Dreidame/
Examiner, Art Unit 3633

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635